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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/209,751	12/11/1998	TORU MATAMA	1110-0212P	6573

7590 07/14/2004

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EXAMINER

GENCO, BRIAN C

ART UNIT	PAPER NUMBER
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2615

22

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/209,751

Applicant(s)

MATAMA, TORU

Examiner

Brian C Genco

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 1998 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 2615

Applicant's amendment filed June 2, 2004 has been fully considered by the Examiner but is not deemed persuasive.

Throughout Applicant's response, Applicant has argued against the Stokes and Leone references individually. Examiner reminds Applicant that in response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that Stokes only scans the selected portion at high resolution.

In response, Examiner notes that there is no limitation indicating that the entire image need be scanned at high resolution. Examiner further notes that it is explicitly taught that the entire image is scanned at high resolution, namely the entire image element 42 of Figs. 2 and 3. Examiner notes that this entire image 42 is scanned in addition to the selected portion 44 of Fig. 44.

Applicant argues that Stokes "is only concerned with performing a quality check on the scanned image" and there is no teaching or suggestion or a need for Stokes to provide red eye correction on page 9.

In response, Examiner notes column 3, lines 11-19 wherein Stokes explicitly teaches that an image modification tool can be used if necessary to modify various characteristics of the digital image 30, such as Adobe's PHOTOSHOPTM. Examiner

Art Unit: 2615

further notes that in making an obviousness rejection that there does not need to be motivation in both of the references being combined. Even if Stokes did not include this explicit teaching, the motivation provided by Leone in the ability to correct an image of defects would be sufficient.

Applicant argues that “the claimed apparatus requires storage of both the high and low resolution image data, a fact which is clearly not true of Stokes” on page 10.

In response, Examiner notes that Stokes explicitly discloses that the high resolution scan data is stored as described on column 3, lines 29-31 and lines 42-44 wherein the image data is read out from the storage so as to be displayed. Examiner notes that Stokes does not explicitly disclose that the low resolution scan is stored, however, it is displayed and thus inherently must be stored somewhere in as much as a display buffer or in a cache to be read out and displayed. Examiner invites Applicant to provide evidence to the contrary should Applicant not agree. As such, Examiner asserts that one skilled in the art would in fact clearly recognize that Stokes does disclose storage of both the low and high resolution image data.

Applicant argues that Stokes does not permit the switching between the high and low resolution images on page 10 and that “This is simply not possible in Stokes.” on page 11.

In response, Examiner notes that it is abundantly clear in Stokes to be able to switch between at least one portion or all portions of the image displayed from the low resolution to the high resolution as that is the whole point of the Stokes invention as

Art Unit: 2615

summarized in the abstract. Examiner further notes that, while it is not explicitly taught by Stokes, it is clearly obvious for Stokes to be able to switch back to the low resolution image since Stokes discloses displaying the images in separate windows and it is an extremely well known function to be able to switch between different windows as was discussed in the previous rejection and admitted by Applicant in their non-traversal of the Official notice taken therein.

Applicant argues that Stokes teaches away from the claimed invention since the proposed modification renders the cited reference unsatisfactory for its intended purpose on page 12.

In response, Examiner notes that Applicant has cited the MPEP 2142.02 and 2143.01, however, there is no 2142.02 section in the MPEP. Examiner notes that Applicant most likely meant to cite MPEP 2141.02. Examiner asserts that Applicant's arguments are merely conclusionary and as such are not deemed persuasive. Applicant must discuss how the Stokes reference teaches away from the claimed invention and why that would overcome the obvious rejection with the combination of Stokes and Leone. Similarly Applicant never discusses how the combination presented by the Examiner renders the cited reference unsatisfactory for its intended purpose.

Applicants arguments on pages 12-13 with regards to the Leone reference alone are moot.

Art Unit: 2615

Applicant argues that there is no motivation to combine the Stokes and Leone references on pages 13 and 14.

In response, Applicant never discusses the motivation presented by the Examiner in the rejection and thus Applicant's arguments against the disparities of the Stokes and Leone reference individually are moot. Examiner notes that Stokes discloses to scan an image at low resolution and select a portion of an image to be viewed at high resolution subsequent to a high resolution scan of the image wherein Stokes explicitly discloses to modify characteristics of the image if necessary. Leone discloses to display an image at low resolution and to select a portion of an image where an artifact such as red eye occurs. That portion is then zoomed in and image processing is preformed to correct it. As such, it would have been obvious to one of ordinary skill in the art at the time of the invention to have added the correction functions of Leone to Stokes in order to enable a user to correct undesirable features or characteristics in an image as suggested by Stokes and explicitly taught by Leone.

Applicant argues that Examiner used impermissible hindsight since "there is no showing in the Office Action that the conclusion of obviousness was reached on the basis of facts gleaned from the prior art, and not from the claimed invention.

In response, Examiner notes that as discussed above the motivation was created based on a suggestion by the Stokes reference and explicit teaching by the Leone reference. Further, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the

Art Unit: 2615

claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant argues that since Stokes does not disclose the red eye correction it is not a valid reference.

In response, Examiner reminds Applicant that the claims were not anticipated under 35 U.S.C. 102 but rather were rendered obvious under 35 U.S.C. 103 wherein as such, not all of the claim limitations must be disclosed by a single reference. Rather, in a 35 U.S.C. 103 obviousness rejection all of the claim limitations must be met by a combination of a plurality of references. As such, the Stokes reference is still valid under a 35 U.S.C. 103 rejection.

Applicant argues on pages 14 and 15 that "Surely, the Examiner does not suggest that one of ordinary skill in the art would look to Stokes et al. with two scans and no 'red-eye' correction and decide, with no motivation to combine, that red-eye correction of Leone et al. is necessary."

In response, Examiner does asserts that one of ordinary skill in the art would look to Stokes, with explicit suggestion to modify characteristics of the image if necessary, that in an image, such as that disclosed by Leone with red-eye in it, the red-eye correction would be necessary. Surely, Applicant can clearly see this clear motivation and strong correlation between the Stokes and Leone references as one skilled in the art clearly would.

Art Unit: 2615

Applicant further argues on page 15 that the combination of Stokes and Leone would eliminate the two scans of Stokes along with corresponding components and a new system would have to be made with one scan and a subsample of that scan together with a new red-eye correction circuit implemented.

In response, this modification does not make any sense. Applicant is asserting that in combining the two references one of ordinary skill in the art would merely strip away all of the teachings of the Stokes reference and insert teachings of the Leone references until Stokes invention was identical to Leone's.

Applicant argues on page 15 that the Examiner "purports a common sense and common knowledge reason for the deficiencies of Stokes".

In response, the Examiner asserts that the motivation was gleaned from explicit teaching in both prior art references. As such the authority rests on the references themselves, and not on the "subjective belief and unknown authority" of the Examiner.

Applicant's arguments on page 16 and 17 with regards to *In re Lee*, 61 USPQ2d 1430 against Examiner's purported motivation that "Stokes [et al.] teaches that upon reviewing an unacceptable image, the high resolution scan can be canceled" fails to "provide factual support for a teaching, suggestion or motivation to modify Stokes et al. constitutes legal error."

In response, Examiner notes that *In re Lee* cited above discusses the use of common knowledge and common sense and as such are not relevant to the rejection since Examiner has provided motivation gleaned directly from the prior art. Further, Examiner

Art Unit: 2615

is baffled by the above quote of Examiners office action since it is not the motivation to combine but merely one of the teachings of Stokes. As such, these arguments are moot.

Applicant argues that it is unclear as to the relevance of the Yamanouchi patent with respect to the claimed invention.

In response, Examiner notes that it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the Yamanouchi is reasonably pertinent to the particular problem with which the applicant was concerned in the limitation of claim 2, namely "means for automatically determining said either one of the execution and the non-execution of the processing from photographing information and means for selecting and indicating said either one of the execution and the non-execution of the processing". In particular, Yamanouchi discloses to automatically perform red-eye correction given certain photographing conditions. As such, the Yamanouchi reference is valid.

Applicant's request to reconsider and withdraw the 35 U.S.C. 103 rejection with DeLuca even though there are no arguments against the DeLuca reference is herein denied.

Examiner's Notes

The official notice presented in the previous action stating that it is extremely well known in the art at the time of the invention to allow a user to switch between windows in order to selectively see a desired window out of multiple windows was not traversed and is accordingly taken as an admission of fact.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitations of claims 2-7 and 9 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

The drawings are objected to because while there are numeric labels on the figures, Examiner requests that text labels also be attached, especially for Fig. 2..

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per

Art Unit: 2615

37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over (USPN 6,295,388 B1 to Stokes et al) in view of (USPN 5,596,346 in view of Leone et al).

In regards to claim 1 Stokes et al., herein Stokes, discloses an image processing apparatus for subjecting input image data of an image obtained by optical photographing to presetted processing and making the input image data to output image data, comprising:

storage means for storing the image data at high resolution that is finely scanned and the image data at low resolution that is pre-scanned (e.g., column 3, lines 29-31 and lines 42-44 wherein the image data is read out from the storage so as to be displayed. Examiner notes that Stokes does not explicitly disclose that the low resolution scan is stored, however, it is displayed and thus inherently the frame of image data must be stored somewhere in as much as a display buffer or in a cache to be able to be displayed);

Art Unit: 2615

a display for displaying the image carried by the image data at high resolution or low resolution that is read from the storage means (e.g., see Figs. 2-6 and the notes above);

display switching means of switching at least one portion or all portions of the image displayed on said display from the low resolution to the high resolution and vice versa (e.g., the display switching means is set by selecting an area 44 of the image to be displayed at high resolution wherein the high resolution scan can be stopped if the high resolution image is unacceptable. Examiner notes that Stokes does not explicitly disclose nor preclude that a user can switch from the high resolution display to the low resolution display, however, Stokes does disclose that the high resolution scan is output to a different window. Examiner notes that it is extremely well known in the art at the time of the invention to allow a user to switch between windows in order to selectively see a desired window out of multiple windows. Official notice is taken. Therefore it would have been obvious at the time of the invention to have enabled the user of Stokes' invention to have selected which window is displayed in order to selectively see a desired window out of multiple windows; column 3, lines 26-28, 42-44, and 53-58; column 4, lines 3-5; Figs. 1-6);

designation means for designating a region in the image of the low resolution displayed on said display by said display switching means (e.g., the designation means is inherent in selecting a detail area within the preview scan; column 3, lines 55-57).

Stokes does not disclose that the designation means necessarily designate a region including an eye or the red eye correction means. Stokes does disclose to modify various characteristics of the image if necessary on column 3, lines 11-19.

Leone et al., herein Leone, discloses zooming in on a region including an eye for detecting red-eye as depicted in Figs. 1A-2D (e.g., column 3, lines 41-47). Upon detecting a red-eye condition Leone discloses the ability to correct the red-eye condition is desired by the user (e.g., column 4, lines 24-37). Leone further discloses the ability to print the image wherein upon pressing a print button a preview image of the entire image after all of the corrections is displayed (e.g., column 7, lines 18-20). Examiner notes that both Stokes and Leone are interested in “zooming” in to a desired location in order to enable a user to determine if the image is acceptable. While Stokes teaches that upon reviewing an unacceptable image, the high resolution scan can be canceled or various characteristics may be modified if necessary, Leone goes on to disclose various functions for correcting the image and further to provide a printing option in order to enable the user to generate a printed copy of the image. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have added the correction functions to Stokes’ invention in order to enable a user to correct undesirable features in an image rather than just discarding the image. As such, the region designated by the designation means is displayed at high resolution before the correction processing. It further would have been obvious to one of ordinary skill in the art at the time of the invention to have added the print feature of Leone’s invention to that of Stokes in order to allow a user to generate a corrected print of an image. As such, the display switching means is more fully defined in that by designating a button the image is switched so as to display a corrected preview of the entire image.

In regards to claim 7 see examiners notes on the rejection of claim 1. Note the disclosed process of zooming-in on the eye takes place before red-eye correction.

Art Unit: 2615

In regards to claim 8 note Figs. 1 and 2 of Stokes' disclosure (column 2, line 62 – column 3, line 14. Also, Leone discloses, "The photographer will sometimes misplace the negatives and only retain the original print. In this situation the original print must be photographed or otherwise captured. This capturing can be done chemically or digitally (column 1, lines 26-30, Leone)," or "input image data of the image obtained by the optical photographing are image data which are read photoelectrically from an image on a photographic film that is photographed and then developed."

In regards to claim 9 see Examiners notes on the rejection of claim 1.

In regards to claim 10 see examiners notes on the rejection of claims 1 and 8. Note that Leone discloses, "the original print must be photographed or otherwise captured (column 1, lines 28-29, Leone)," wherein "image data obtained directly by photographing a subject" falls under the category of being "otherwise captured." Also note that it is well know in the art and obvious to one skilled in the art to interchange taking photographic pictures using both photographic film and digital imaging devices such as CCD's. Further note that the scanning devices disclosed by both Stokes and Leone do directly photograph a subject, namely the film.

Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over (USPN 6,295,388 B1 to Stokes et al) in view of (USPN 5,596,346 in view of Leone et al) in further view of (USPN 5,420,699 to Yamanouchi et al).

In regards to claim 2 see examiners notes on the rejection of claim 1. Note Leone's disclosure, wherein, "As depicted in FIG. 1D on of the eyes of the subject 24 is now positioned in the center of the window 22 and the view port 32 is also centered on

Art Unit: 2615

the eye as well as being of a size where only the area around the eye is defined as being within the view port 34. The user can now determine if the “red-eye” condition exists in the eye shown in the window 22. If the condition exists the user can activate a conventional process for correcting the artifact condition by touching the apply button 18. This will result in the portion of the source image 32 seen by the user in the window 22 (as defined by the view port 34) being processed (column 4, lines 23-31, Leone),” or “means for selecting either one of execution or non-execution of processing by said display switching means, said designation means and said red eye correction means as a mode,” whereby if the disclosed user doesn’t detect the red-eye condition then non-execution of processing will be preformed. Leone does not disclose “means for automatically determining said either one of the execution and the non-execution of the processing from photographing information and means for selecting and indicating said either one of the execution and the non-execution of the processing.”

Yamanouchi et al, herein Yamanouchi, discloses “a transparent magnetic recording layer is coated on the side opposite to a light sensitive surface of a film base of the film (column 3, lines 36-38, Yamanouchi)” depicted in Fig. 1 element B, as well as “image pattern B includes information of conditions necessary for printing process such as weather in the course of photographing, time of photographing and whether a strobe was used or not (column 3, lines 46-50, Yamanouchi),” and finally that “optical information sensor S1 reads the aforementioned image pattern B first, the data thereof are sent to an optical information analyzing unit, and for example, filter f1 is selected so that color correction corresponding to the aforesaid photographing conditions may be made (column 4, lines 46-50, Yamanouchi),” wherein the disclosed optical information

Art Unit: 2615

analyzing unit automatically determines processing functions, such as color correction or red-eye correction based on the information recorded on image pattern B. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have “at least one of means for selecting either one of execution and non-execution of processing by” either user input commands as disclosed by Leone or by automatic determination means based on pre-recorded information about the photographing conditions as disclosed by Yamanouchi.

In regards to claim 3 see examiners notes on the rejection of claim 2.

Yamanouchi discloses “image pattern B includes information of conditions necessary for printing process such as weather in the course of photographing, ...and whether or not a strobe was used (column 3, lines 45-49, Yamanouchi),” wherein all of the claim limitations listed in claim 3 are necessary for determining the possibility of red-eye occurring in a picture and are therefore necessary for printing process. It would have been obvious to one of ordinary skill in the art at the time of the invention to record information about the photographing conditions as disclosed in Yamanouchi in order to allow more information to the user “for the purpose of efficient printing (column 1, line 57, Yamanouchi).”

In regards to claim 4 Yamanouchi discloses recording information such as whether a strobe was used or not as noted above wherein it is very well known and established in the art that if a strobe or flash was not used then there is no possibility of having red-eye defects in a picture and as noted above in the rejection of claim 2 the determination means would note that there is not possibility for red-eye to have occurred

Art Unit: 2615

in the picture and therefore would not do red-eye processing on the picture or “means for determining the non-execution of the processing.”

In regards to claim 5 see examiners notes on the rejection of claims 3 and 4.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over (USPN 6,295,388 B1 to Stokes et al) in view of (USPN 5,596,346 in view of Leone et al) in further view of (USPN 5,420,699 to Yamanouchi et al) in further view of (USPN 6,407,777 to DeLuca).

In regards to claim 6 Leone and Yamanouchi disclose the red-eye removal processing however do not disclose how this processing takes place. DeLuca discloses, “FIG. 5 shows combination pupil/iris pixels which have color components of the red-eye phenomenon ... The invention modifies these pixels by separating the color components associated with the red-eye, modifying color of the separated color components and then adding back modified color to the pixel (column 4, lines 44-50, DeLuca),” or “image take-out means,” “color transform means,” and “image data replacing means.” Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have used DeLuca’s red eye processing method so as to fully define the red-eye processing disclosed by Leone and Yamanouchi.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian C. Genco who can be reached by phone at 703-305-

Art Unit: 2615

7881 or by fax at 703-746-8325. The examiner can normally be reached on Monday thru Friday 8:30am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on 703-308-9644. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is 703-308-4357.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brian C Genco
Examiner
Art Unit 2615

June 25, 2004



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